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**RESPONSE TRANSMITTAL**

Applicant : Jones, et al.
App. No : 09/659,866
Filed : September 12, 2000
For : INTEGRATED EMERGENCY
MEDICAL TRANSPORTATION
DATABASE SYSTEM
Examiner : Pass, Natalie
Art Unit : 3626

CERTIFICATE OF MAILING

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September 1, 2006

(Date)

John M. Carson, Reg. No. 34,303

Mail Stop Appeal Brief-Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Reply to Examiner's Answer in 10 pages.
- (X) Request for Oral Hearing in 1 page.

The fee has been calculated as shown below:

The present application qualifies for Small Entity Status under 37 CFR 1.27.

FEE CALCULATION				
FEE TYPE		FEE CODE	CALCULATION	TOTAL
Request for Oral Hearing	41.20(b)(3)	1403/2403		\$500
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- (X) A check in the amount of \$500 is enclosed.
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Docket No.: GOLDENH.001C1

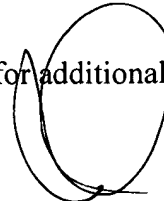
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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John M. Carson, Reg. No. 34,303

REPLY TO EXAMINER'S ANSWER**Mail Stop Appeal Brief - Patents**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Examiner's Answer mailed on July 5, 2006, Appellant submits the following Reply Brief to address the arguments presented therein.

Summary of Response

In the Examiner's Answer, the Examiner maintains the rejection of the pending claims, including independent Claims 2, 10, and 15:

- 1) The Examiner maintains that the *Declaration Under 37 C.F.R. 1.131 to Overcome Aeromed* submitted by Appellant is insufficient to overcome the Aeromed reference;
- 2) The Examiner maintains that the Aeromed reference is an enabling reference with respect to "instructions for dispatching an aircraft;"

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- 3) The Examiner maintains that the Aeromed reference discloses "instructions for determining whether the actual flight path varies from the calculated flight path;" and
- 4) The Examiner maintains that the Nathanson reference discloses "instructions for determining whether the actual flight path varies from the calculated flight path."

Appellant addresses each of the above items in the remarks below.

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REMARKS

As an initial matter, Appellant thanks Examiner for the identification of typographical errors and agrees with each of Examiner's assumptions with respect to what was meant by Appellant in the initial Appeal Brief.

I. The Declaration Under 37 C.F.R. 1.131 to Overcome Aeromed submitted by Appellant is sufficient to overcome the Aeromed reference

The Examiner appears to have maintained the same arguments with respect to the sufficiency of the *Declaration Under 37 C.F.R. 1.131 to Overcome Aeromed* (hereinafter "*Declaration*"), each of which Appellant has previously addressed in the Appeal Brief. These points are briefly addressed in summary below.

As an initial matter, the Examiner appears to have maintained the argument, presented in prior Office Actions, that the language used in the *Declaration* is "unclear as to what was actually reduced to practice and what was undergoing due diligence." Appellant reiterates that the *Declaration*, in conjunction with the attached Exhibit Sheets, is sufficient to establish actual reduction to practice prior to the effective date of the Aeromed reference, and that in the alternative, the *Declaration*, in conjunction with the attached Exhibit Sheets, is sufficient to establish conception of the claimed invention coupled with due diligence during the short period of time between the effective date of the Aeromed reference and the filing date of the parent application. Appellant notes again that the language used in the *Declaration*, to which the Examiner has objected, is based on the language utilized in 37 C.F.R. § 1.131.

The Examiner appears to have also maintained the argument, previously presented and addressed by the Appellant, that the *Declaration* and accompanying Exhibit Sheets do not establish actual reduction to practice due to the use of predictive language in parts of a single Exhibit Sheet. The Examiner has not presented additional arguments in the Examiner's Answer with respect to the establishment of actual reduction to practice beyond a statement that the Examiner finds the arguments set forth by the Appellant in the Appeal Brief "when interpreted together with the Exhibits referred to in these arguments, (Appellant's affidavit filed 20

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December 2004), to be non-persuasive to show that the apparatus actually existed and worked for its intended purpose prior to February 5, 1998.” First, this addresses only one prong of Appellant’s arguments. Second, Appellant reiterates that each of the features of Claims 2 and 9 is supported by non-predictive language and figures in other Exhibit Sheets, and that the term “other potential uses” in Exhibit Sheet D, identified by the Examiner as one of the two predictive phrases, is followed immediately by the phrase “[a] variety of functions can be performed by the individual computers in addition to the clinical medical record...” (emphasis added). Furthermore, Appellant argues alternately to actual reduction to practice, there was conception coupled with diligence.

In addition, Appellant notes that, if the *Declaration* and accompanying exhibits are not found to have established actual reduction to practice prior to the effective date of the Aeromed reference, the *Declaration* and accompanying exhibits are sufficient to establish conception coupled with due diligence. The Examiner has argued that Appellant must be specific as to dates and facts. However, Appellant notes that, so long as conception prior to the effective date of the Aeromed reference has been shown, Appellant need only show diligence during a critical period of less than one month. Appellant notes that the *Declaration* and accompanying exhibits has provided dates and facts to establish conception of the claimed invention prior to February 5, 1998, and respectfully submits that the existence of a beta test version of the software prior to February 5, 1998 is sufficient to show diligence during the critical period of less than one month, until the filing date of March 2, 1998.

For at least the above reasons, Appellant respectfully submits that the *Declaration Under 37 C.F.R. 1.131 to Overcome Aeromed* is sufficient to overcome the Aeromed reference, as the *Declaration*, along with the accompanying exhibits, is sufficient to show actual reduction to practice prior to the effective date of the Aeromed reference, or conception coupled with due diligence during the critical period.

II. The Aeromed reference is not an enabling reference with respect to “instructions for dispatching an aircraft”

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Claim 2 recites the feature of “a computerized system for managing airborne transportation of a patient, comprising a first module comprising instructions for dispatching an aircraft carrying an airborne emergency transport crew to a patient site.” Appellant submits that the Aeromed reference does not contain an enabling disclosure of this feature.

The Examiner has first cited *In re Epstein* (Fed. Cir. 1994) for the proposition that “lack of diagrams, flow charts, and other details in the prior art references did not render them non-enabling in view of the fact that applicant’s own specification failed to provide such detailed information, and that one skilled in the art would have known how to implement the features of the references.” Appellant notes that the arguments previously presented have revolved around the lack of disclosure in the cited portion of the Aeromed reference relative to the large amount of such disclosure presented in Appellant’s application. While the detailed information of the type referred to in *In re Epstein* is indeed lacking in Aeromed, such detailed information is provided in Appellant’s application, as set forth in the Appeal Brief, and Appellant submits that this information, particularly the flowcharts and detailed descriptions thereof, is information of the type that would be required, even by a skilled artisan, to develop the claimed computerized system without undue experimentation. See, e.g., *Appeal Brief*, at page 14, second full paragraph, to page 17, first paragraph, and *Specification*, at Figures 2-4 and pages 7, 8-10, 15-16, and 17-18.

The Examiner has also cited *In re Crosby* (CCPA 1946) for the proposition that “the claims represented by applicant must distinguish from the alleged inoperative reference.” In *In re Crosby*, the Appellant had argued that the cited reference was inoperative, and the CCPA stated that even if the reference is inoperative, the claims must distinguish from the disclosure, and that the elements of the claim were in fact disclosed by the cited reference, even though the device as a whole may have been inoperable. In contrast to the *Crosby* argument of inoperability, Appellant submits that the Aeromed reference does not disclose “a computerized system for managing airborne transportation of a patient, comprising a first module comprising instructions for dispatching an aircraft carrying an airborne emergency transport crew to a patient site,” as the cited portion of the reference merely describes a list of features, as previously set forth in the Appeal Brief, and does not disclose instructions for dispatching an aircraft, as recited in Claim 2. Crosby is inapplicable, and thus, Appellant submits that the term “instructions for

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dispatching an aircraft” distinguishes Claim 2 from the Aeromed reference, as no instructions for dispatching an aircraft are taught or suggested by the small portions of the Aeromed reference relevant to this claimed feature.

The Federal Circuit has previously stated that “a one page promotional brochure boasting of the ability and the results of a process is insufficient as a matter of law to constitute an enabling disclosure of that process.”¹ Appellant submits that the Aeromed reference is little more than promotional material which outlines the features of the Aeromed system, and that it cannot constitute an enabling reference with respect to “instructions for dispatching an aircraft.”

The Examiner has also noted that the entire applied reference must be considered when evaluating whether or not the applied reference teaches the cited limitations. Appellant notes, however, that even in the Examiner’s Answer, the Examiner has not cited any portion of the Aeromed reference other than that originally cited, and notes that the Examiner has not pointed to any disclosure beyond the originally cited portion which contains disclosure relevant to the feature of instructions for dispatching an aircraft. For at least the above reasons, Appellant respectfully submits that the Aeromed reference is not an enabling disclosure with respect to the feature of instructions for dispatching an aircraft, and that the claimed feature of instructions for dispatching an aircraft distinguishes over the Aeromed reference.

III. The Aeromed reference does not disclose “a first module comprising instructions for determining whether the actual flight path varies from the calculated flight path”

The Examiner has stated that:

“The Examiner understands the Aeromed reference to teach a system which produces flight plans and also to teach features that calculate navigation for the entire flight plan and display nearest aircraft to scene (in order to determine the nearest aircraft to the scene the system in Aeromed must determine the actual location of the aircraft), and thus determines the deviation from the calculated flight plan. Furthermore, Examiner interprets the Aeromed reference as providing instructions to the user for determining whether the actual flight path varies from the calculated flight path, i.e. “Aeromap shows you the flight plans of all active

¹ *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984)

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units as lines on the map. Position reports are shown as dots. *Watch your aircraft* as it flies to its destination! You can easily tell if it is off-course [read on “instructions for determining whether the actual flight path varies from the calculated flight path”] (emphasis added)”

The Examiner has further stated that:

“Examiner interprets Aeromed’s teachings on page 10, paragraph 1, i.e., “Tired of following your units by hand? AeroMap connects directly to the Newcomb satellite transceiver to get position reports and unit status automatically” (emphasis added) as teaching using a computerized system.”

Appellant first notes that a determination of a closest aircraft to a scene is a determination of the distance between a fixed point and a current position, and not a determination of whether a calculated flight path varies from an actual flight path, and thus, no determination of a deviation from a calculated flight path can be made. Appellant also notes that to the extent the Aeromed reference mentions any comparison between a position report and a flight plan, it is a comparison between a position and a path, rather than a path-to-path comparison, as recited in Claim 2.

In addition, Appellant notes that in Aeromed, the comparison between a position report and a path is done visually by a user. In contrast, Claim 2 recites “a computerized system for managing airborne transportation of a patient, comprising ... a third module comprising instructions for ... determining whether the actual flight path varies from the calculated flight path.” Appellant respectfully submits that the cited portion of the Aeromed reference does not teach this claimed feature.

In arguing that Aeromed teaches using a computerized system, the Examiner has pointed to disclosure of automatically obtaining position reports, but has pointed to no disclosure that a computerized determination of whether an actual flight path varies from a calculated flight path. Appellant respectfully submits that the Aeromed reference does not teach or suggest the claimed feature of “a computerized system for managing airborne transportation of a patient, comprising ... a third module comprising instructions for ... determining whether the actual flight path varies from the calculated flight path.”

IV. The Nathanson reference does not disclose “instructions for determining whether the actual flight path varies from the calculated flight path”

The Examiner has stated that:

“Examiner notes that Nathanson teaches ‘an automated vehicle locator system’ that ‘automatically update[es] the actual position of the vehicles on the graphic display monitor ... [...] ... displayed in the form of coordinate maps’ and ‘[t]he software of the deliver system is organized into three main programs supported by numerous subroutines and functions’ and ‘the dispatcher ... [...] ... program ... [...] ... assigns routes to selected vehicles, calculates the minimum path travel times for those routes and monitors the successful completion of pick-ups and deliveries,’ (Nathanson; column 4, lines 1-27). Furthermore, Nathanson teaches ‘the vehicle itinerary files is updates and time stamps are placed on the transaction showing estimated time of pickup and estimated time of deliveries’ and ‘[t]he third check mark represents a confirmation of arrival at the destination point and is represented by the letter “D” when confirmed (Nathanson; column 19, lines 35-65). Examiner interprets these teachings of software (reads on “instructions”) that monitors travel times and actual positions of vehicles traveling on assigned routes to teach, ‘instructions for tracking the actual ... [...] ... path of the vehicle and determining whether the actual ... [...] ... path varies from the ‘assigned’ (reads on ‘calculated’) path.’”

The Examiner appears to maintain the argument that the recordation of estimated and actual times of pickup and deliveries constitutes determining whether an actual path varies from an assigned path. As discussed in previous responses, Appellant respectfully submits that such recordation of times, even in conjunction with a calculated minimum path, cannot constitute determining whether the actual path varies from the calculated path, as the path could be followed exactly, but take more or less time, or an alternate path taken, but traversed in the expected amount of time.

Although the Examiner has argued that Nathanson teaches a system that automatically updates the actual position of vehicles on a display monitor, Appellant notes that this does not teach instructions for determining whether an actual flight path varies from a calculated flight path. Similarly, the Examiner has interpreted Nathanson to teach displaying this information to many participants in the dispatch and tracking system. Appellant notes that even if this interpretation is reasonable, the display of such information to multiple participants, rather than to a single participant, does not affect Nathanson’s failure to teach or suggest instructions for determining whether an actual flight path varies from a calculated flight path.

Finally, the Examiner has noted that “Claim 2 is directed to instructions for tracking and instructions for determining, and not to actually tracking and determining.” (emphasis in original)

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While Claim 2 is in fact directed to “a computerized system for managing airborne transportation of a patient, comprising ... a third module comprising instructions for ... determining whether the actual flight path varies from the calculated flight path,” Appellant respectfully notes that Claim 15, which has also been rejected by the Examiner as obvious over Nathanson in view of Schriewer, recites “tracking the actual flight path of the aircraft; and determining whether the actual flight path varies from the calculated flight path,” and does not use the term instructions.

The Examiner has stated, with respect to the rejections based on both the Nathanson and Aeromed references, that the Appellant “fails to appreciate the breadth of the claim language that is presently recited.” Appellant respectfully submits that, for the reasons set forth both previously and in the instant brief, the Examiner is giving a broader reading to the cited references than is appropriate, that Appellant relies on the text of the claims, and that the feature as recited in Claim 2 of “a computerized system for managing airborne transportation of a patient, comprising ... a third module comprising instructions for ... determining whether the actual flight path varies from the calculated flight path” is simply not taught or suggested in any of the cited references, nor are the similar features recited in independent Claims 10 and 15.

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CONCLUSION

In view of the foregoing arguments, Appellant respectfully submits that Claims 2-19 are patentable over the prior art of record.

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Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

9/1/06

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AMEND

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